

PATENT
W&B Ref. No. : INF 2284-US
Atty. Dkt. No. INFN/WB0073

REMARKS

This is intended as a full and complete response to the Restriction Requirement dated August 29, 2005, having a shortened statutory period for response set to expire on September 29, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-21 are pending in the application. Claims 1-21 remain pending following entry of this response. Claims 14 and 18 have been amended. Applicants submit that the amendments do not introduce new matter.

Claims 1-21 stand restricted under 35 U.S.C. 121 as follows:

- I. Claims 17-21, drawn to a semiconductor process, classified in class 438, subclass 14.
- II. Claims 1-16, drawn to a semiconductor device, classified in class 257, subclass 048.

The Examiner states that the inventions are distinct, each from the other, because of the following reasons:

"Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as one in which measured value is read out via a different pad."

Applicants provisionally elect, with traverse, the claims of Group II (claims 1-16) for examination. There are two criteria for a proper requirement for restriction between patentably distinct inventions: (A) The inventions must be independent; and (B) There must be a serious burden on the examiner if restriction is required. (MPEP § 803). Applicants submit that the Examiner has not properly established or satisfied the criteria for a proper requirement for restriction.

Applicants submit that the Examiner has incorrectly applied the criteria for distinguishing inventions that are related as a process of making and product made to

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the claims of the present invention. The Examiner has incorrectly interpreted the claims of Group I (claims 17-21), which are directed to "method of checking a function of a circuit in an integrated circuit," as a process for making the apparatuses claimed in the claims of Group II. Clearly, the apparatuses claimed in the claims of Group II are not made by the methods claimed in Group II. Thus, the claims of Group I and the claims of Group II are not related as process of making and product made. Therefore, Applicants submit that the restriction requirement is improper since the Examiner has not properly established that the inventions are distinct and respectfully request withdrawal of the restriction requirement.

Having addressed all issues set out in the Restriction Requirement, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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